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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,761	08/22/2000	Wataru Inoha	24355	8070

7590 03/12/2004

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EXAMINER

TRIEU, LAURENT L

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/642,761

Applicant(s)

INOHA, WATARU

Examiner

Laurent Trieu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2000.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 22 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. Claims 16 & 17, as best understood, recite non-functional descriptive matter. The organization of the data does not apparently affect the operation of a device.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 16 & 17 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: how the encrypted data stored on the storage medium is used.
4. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: active, positive steps clearly setting forth limitations in sequential order. For example, in claims 1 & 3, it is unclear

whether executing the data usage accounting procedure is truly required prior to transferring the encrypted data.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 7-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Slik et al., U.S. Patent Number 5,809,145, hereafter referred to as Slik.

Regarding claim 1, 7 & 11 – Slik discloses the following:

- “A system for distributing digital data...to accommodate different data preview, search, data compression and encryption functions, and different purchase transactions.” (Abstract)
- “Customers can therefore sample and preview datasets before deciding to purchase them...” (Column 8, lines 23-38) reads on digital sample preview data.
- Figures 4 & 5 show users requesting/accessing data via a network.
- “Any type of information that can be digitized can be assembled as a dataset for viewing and purchasing ...” (Column 6, lines 16-17), “the datasets can be verified by the information providers 11, encrypted and stored...” (Column 6,

lines 19-20), "The datasets can be stored on a relational database server, on a WWW server..." (Column 6, lines 42-50) - reads on enciphered digital data being transmitted from source to user over a network.

- "A user can select a dataset and initiate a request by clicking on an item in a preview screen" (column 17, lines 66-67) - reads on "a user terminal executes a data usage accounting procedure."
- "The transaction server in turn provides the computer with an access or release code via the gateway server 36 and the network 22 after a pay method is established" (column 7, lines 27-30) – reads on decryption key data for deciphering is transmitted to user.
- "The price for purchasing the dataset" (Column 8, line 1) - reads on additional data required for accounting.

Regarding claim 8 – Slik discloses "The encrypted key is concatenated with the hashed dataset code (block 252), compressed, and sent as a release code to the customer (block 354)." (Column 18, lines 19-22)

Regarding claims 10 & 12 – Slik teaches "a user can select a dataset and initiate a request by clicking on an item in a preview screen..." (Column 17, lines 66-67) Then "the product code is forward to the fulfillment center" (Column 18, lines 12-13) reads on receiving means. Subsequently, "the encrypted key is concatenated with the hashed dataset code (block 252), compressed, and sent as a release code to the customer

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(clock 354)" (Column 18, lines 19-22) reads on transmitting means for transmitting enciphered data.

Regarding claims 13 and 15 – Slik teaches "a user can select a dataset and initiate a request by clicking on an item in a preview screen..." (Column 17, lines 66-67)

Consequently, "the encrypted key is concatenated with the hashed dataset code (block 252), compressed, and sent as a release code to the customer (clock 354)" (Column 18, lines 19-22) reads on receiving means for receiving enciphered data. The computers 12 are preferably conventional personal computers which comprise a monitor 13, an optional hard drive 15 or other local memory device..." (Column 5, line 65+) reads on recording and reproducing means. "The dataset can then be decrypted using the release code" (Column 7, lines 14-15) reads on deciphering means.

Regarding claim 14 - Figure 1 shows customer computers 12a and 12c connected to the communications network 22. Networked computers may copy information to one another.

Regarding claims 16 & 17, as best understood - Figure 1 shows "CD-ROM drive 18" in the information provider's & "CD-ROM 20" and "Hard Drive 15" in the customer's computer. These storage devices read on "a data recording medium with enciphered copyrighted digital data..."

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***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-6 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benson et al, U.S. Patent US 6,301,660 B1, hereafter referred to as Benson, in view of Slik.

Regarding claims 2 & 9 - While Slik teaches sharing encrypted information; it does not require deciphering the enciphered data prior to reproduction. Benson teaches about using a special viewer (column 9, lines 5-22) that will reproduce "Protected Format" files (displaying movie, playing audio files) with a specially constructed Viewer programs" (Column 9, lines 37-42) reads on deciphered encrypted data. ) It would have been obvious at the time of the invention to modify Slik to require decryption of enciphered data prior to reproducing it. The motivation would have been to allow users to use the decrypted information (display movie, play audio file) instead of using the raw encrypted data.

Regarding claims 3-6 – While Slik discloses sending encrypted information between user and server hosts, it does not specifically teach about sharing such information between users. Benson teaches "the present invention prohibits the third customer from forwarding the documents to any unauthorized customer unless the authorized

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third customer is also an authorized distributor. (Column 1, lines 53-55). It would have been obvious at the time of the invention to modify Slik to allow for users to share information/software as shown by Benson. The motivation would have been to entice the users into buying the information/software by allowing users to preview/test it prior to purchasing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurent Trieu whose telephone number is 703-305-0712. The examiner can normally be reached on Monday - Friday, 7AM - 4PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LLT

  
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02 March 2004